

### **REMARKS**

Applicant appreciates the Examiner's thorough consideration provided in the present application. Claims 1-10 are currently pending in the instant application. Claims 2 and 10 have been amended. Claims 1, 7 and 10 are independent. Applicant appreciates the courtesies extended to Applicant's representative during the interview of February 26, 2004. During the interview, the rejection under 35 U.S.C. § 112, first paragraph and the objections to the drawings were discussed. Reconsideration of the present application is earnestly solicited.

#### **Reasons for Entry of Amendments**

As discussed in greater detail hereinafter, Applicant respectfully submits that the rejections under 35 U.S.C. § 103(a) is improper and should be withdrawn. Accordingly, the finality of the Final Office Action mailed on September 3, 2003 should be withdrawn.

If the Examiner persists in maintaining his rejections, Applicant submits that this Amendment was not presented at an earlier date in view of the fact that Applicant is responding to a new ground of rejection set forth in the Final Office Action. In accordance with the requirements of 37 CFR 1.116, Applicant

respectfully requests entry and consideration of the foregoing amendments as they remove issues for appeal with respect to the claims and the drawings.

### **Allowable Subject Matter**

Applicant appreciates the Examiner's indication of allowable subject matter. Specifically, claim 7 has been allowed. In addition, as discussed in greater detail hereinafter, Applicant submits that the remaining claims should also be allowed and the present application should be passed to Issue.

### **Specification**

Applicant has voluntarily amended the specification to provide a proper cross reference to additional FIG. 4 requested by the Examiner. In addition, the specific language of amended claim 10 has been added to the specification to provide proper antecedent support for this claim as further shown in FIG. 2(A).

### **Drawings**

The drawings have been objected to due to the presence of alleged minor informalities. These objections are traversed. Applicant has filed formal

drawings concurrently herewith that address the Examiner's requested changes. Accordingly, this objection has been obviated and/or rendered moot.

With respect to the features of claim 6, Applicant submits that a loop pipe (element 21 in the specification and in FIG. 2), as would be appreciated by one of ordinary skill in the art, is properly shown in the drawings. However, without conceding the propriety of the Examiner's rejection, but merely to timely advance the prosecution of the present application, Applicant has submitted formal drawing FIG. 4 which provides a detailed view of a loop pipe (element 21). Accordingly, this objection has been obviated and/or rendered moot.

With respect to the features of claim 10 cited by the Examiner as being unsupported in the drawings, Applicant has amended claim 10 to clarify the claimed invention for the benefit of the Examiner. Applicant submits that the features of claim 10 are clearly shown in FIG. 2(A) of the present application. Accordingly, this objection has been obviated and/or rendered moot.

### **Claim Rejections Under 35 U.S.C. § 112**

Claim 10 stands rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement. This rejection is traversed.

In light of the foregoing amendments to the claims, Applicant respectfully submits that these rejections have been obviated and/or rendered moot. However, Applicant respectfully submits that the foregoing amendments have been made to merely clarify the claimed invention for the benefit of the Examiner.

Without conceding the propriety of the Examiner's rejection, but merely to timely advance the prosecution of the application, Applicant has incorporated the changes recommended by the Examiner. Applicant submits that the requested changes do not appear to either raise a substantial question of the patentability of the claimed invention nor do they narrow the scope of the claimed invention.

### **Claim Rejections Under 35 U.S.C. § 103**

Claims 1, 5, 6, 8 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsuzaka (Japanese Patent Document No. JP 3-96693) in view of Altstadt et al (U.S. Patent No. 6,289,776). Claims 2 and 3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsuzaka in view of Altstadt et al., and further in view of Ellis (U.S. Patent No. 4,544,334). This rejection is respectfully traversed.

In light of the foregoing amendments to the claims, Applicant respectfully submits that these rejections have been obviated and/or rendered moot. Applicant respectfully submits that the prior art of record fails to teach or suggest each and every limitation of the unique combination of limitations of the claimed invention. Accordingly, this rejection should be withdrawn.

For example, with respect to claim 1, Applicant submits that the prior art of record fails to teach or suggest the limitation(s) of “*a structure for reducing noise and vibration in a scroll compressor, comprising an outer casing operatively connected with a suction pipe and discharge pipe; an inner casing engaged with an inner circumferential surface of the outer casing; a driving motor engaged with the inner circumferential surface of the inner casing, for generating a rotational force; a driving shaft engaged with a rotor for transmitting the rotational force; a fixed scroll forming a discharge port, and arranged with an orbiting scroll so as to have a plurality of compression pockets, said orbiting scroll eccentrically engaged with the driving shaft, wherein said compression pockets continually move during an orbital motion of said orbiting scroll; a frame affixed on the inner circumferential surface of the inner casing for supporting the driving shaft; and an elastic support device for elastically supporting ends of the outer casing and the inner casing.*” (emphasis added) Accordingly, this rejection should be withdrawn.

The Examiner acknowledges that Matsuzaka is clearly not directed toward a scroll compressor. Although the Examiner suggests that scroll compressors are functionally equivalent to rotary compressors, this opinion is once again respectfully traversed. Applicant does not doubt the Examiner's personal knowledge of the compressor art. However, Applicant is traversing the Examiner's allegation that one of ordinary skill in the art would have attempted the structural substitutions suggested by the Examiner. The Examiner has attempted to show that the combination of limitations of the claimed invention are shown individually in various references. However, the Examiner has not provided a motivation to alter these references to read on the claimed invention that is actually taught or suggested in the references themselves. Accordingly, Applicant traverses this use of Official Notice to allege what is known to one of ordinary skill in the art.

The Examiner has indicated that scroll compressors are functionally equivalent to and *more* efficient than rotary compressors. The passage relied upon by the Examiner to support this alleged motivation to alter the rotary compressor of Matsuzaka merely states that scroll compressors are capable of "extremely efficient operation." However, this passage does not contrast the efficiency of rotary compressors with that of scroll compressors. The Examiner's stated motivation to alter the Matsuzaka reference is NOT that

scroll compressors are efficient, but that one of ordinary skill in the art would have replaced the rotary scroll compressor structure of Matsuzaka with the *more efficient* structure of Altstadt et al. Applicant's traversal is on the basis that this motivation is not taught or implicitly suggested in the references themselves. Further, the Examiner has not provided a reference that suggests that the compressive portions of rotary compressors and scroll compressors are routinely substituted for one another as alleged by the Examiner.

Accordingly, Applicant respectfully requests that the Examiner support this allegation with actual evidence in the official record. The passage, i.e., col. 1, lines 14 to 17, of Altstadt et al. clearly does not provide proper support for the Examiner's alleged motivation to alter the prior art of record. Therefore, Applicant repeats the traversal of the Examiner's use of official notice to provide a motivation to alter the Matsuzaka reference in view of Altstadt et al.

The claimed invention is particularly aimed at overcoming vibration and noise associated with scroll compressors, e.g., as described in Applicant's description of the problems associated with the background art in pages 1-3 of the present application. Applicant submits that it is clear that structure of the scroll compressor is claimed in relation to the noise attenuation structure since the claimed invention is directed toward problems associated with noise and vibration in scroll compressors.

Accordingly, absent the benefit of Applicant's own disclosure, the Examiner has not identified any reason in the prior art of record as to why one of ordinary skill in the art would modify the rotary compressor of Matsuzaka to be a scroll compressor. For example, there do not appear to be any art recognized problems with the structure of Matsuzaka et al. that would require a modification as advanced by the Examiner. Further, Altstadt et al. does not teach or suggest that rotary compressors should be replaced by scroll compressors. Applicant submits that the Examiner is alleging that the rotary compressor of Matsuzaka should be modified to be a scroll compressor, but only so far as to still read on the claimed invention. This rejection is clearly improper.

Applicant respectfully submits that the Examiner has not established a reason why one of ordinary skill in the art would modify the structure of Matsuzaka compressor to be a scroll compressor, but still retain the features of the elastic supporting means, etc. Applicant submits that the Examiner has merely attempted to identify that the Matsuzaka device could be modified, but has not identified any reason as to why one of ordinary skill in the art would attempt to do so without the benefit of Applicant's own disclosure. Accordingly, this rejection should be withdrawn.



In accordance with the above discussion of the patents relied upon by the Examiner, Applicant respectfully submits that these documents, either in combination together or standing alone, fail to teach or suggest the invention as is set forth by the claims of the instant application.

As to the dependent claims, Applicant respectfully submits that these claims are allowable due to their dependence upon an allowable independent claim, as well as for additional limitations provided by these claims.

### **CONCLUSION**

Since the remaining patents cited by the Examiner have not been utilized to reject the claims, but rather to merely show the state-of-the-art, no further comments are necessary with respect thereto.

All the stated grounds of rejection have been properly traversed and/or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently pending rejections and that they be withdrawn.

It is believed that a full and complete response has been made to the Office Action, and that as such, the Examiner is respectfully requested to send the application to Issue.

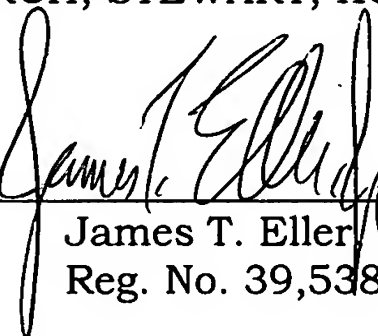
In the event there are any matters remaining in this application, the Examiner is invited to contact Matthew T. Shanley, Registration No. 47,074 at (703) 205-8000 in the Washington, D.C. area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment(s): Drawings - One (1) sheet